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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,151	01/16/2001	Yat-Tung Lam	MP0071	2849

23624 7590 06/30/2004

MARVELL SEMICONDUCTOR, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
700 FIRST AVENUE, MS# 509  
SUNNYVALE, CA 94089

EXAMINER

KING, JUSTIN

ART UNIT	PAPER NUMBER
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2111

16

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application

09/759,151

Examiner

Justin I. King

Applicant(s)

LAM ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-247 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-247 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

There are duplicated claim numbers 225, 231, and 232. The second occurrence of each duplicated number has been marked to 225', 231', and 232' accordingly for the purpose of restriction.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-11, 15-25, 31-41, 46-56, 60-70, 76-86, 91-104, 106-107, 121-131, 135-136, 151-161, and 212-222 are drawn to an interface with split transaction capability, classified in class 710, subclass 105.
  - II. Claims 12-13, 26-27, 42-43, 57-58, 71-72, 87-88, 102-103, 117-118, 132-133, 146-147, 162-163, 166-169, 170-173, 175-176, 178-182, 185-188, 189-192, 194-195, 197-200, 200', 203-210, 223-224, 225', 226-229, and 230-232 are drawn to an interface with a sync mark transceiver, classified in class 710, subclass 105.

- III. Claims 14, 28-27, 30, 44-45, 59, 73-75, 89-90, 104-105, 119-120 134, 148-150, 164-165, and 225 are drawn to an interface with a ready transceiver, classified in class 710, subclass 105.
- IV. Claims 174, 177, 183-184 193, 196, 201-202 211, and 231' are drawn to an interface with a parse circuit, classified in class 710, subclass 305.
- V. Claim 232', 233, 234-239, 240-243, and 244-247 are drawn to an interface implemented in a computer program with a functions of a controller, a parse circuit, and a sync mark transceiver, classified in class 710, subclass 305.

3. The first, third, and forth inventions are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the first invention discloses a capability of split transaction, the third invention discloses a ready transceiver, and the forth invention discloses a parse circuit. The specification and claims do not show or enable that they are capable of use together, and according to the claim language, each invention has different mode of operations.

5. The first and second inventions are related as combination and subcombination, and the subcombination is not essential to combine ( $AB_{\text{broad}}/B_{\text{Specific}}$ ). In the instant case, the first invention is the combination of split transaction and the second invention's sync mark circuit. The second invention has more specific limitations. See MPEP 806.05(c).

6. The second and fifth inventions and forth and fifth inventions are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the

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combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the fifth invention is the combination of the second and forth invention, and the combination as claimed does not require the particulars of the subcombination as claimed and either second or forth invention has the utility by itself because they are independently claimed.

7. The second and forth inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, both inventions are independently claimed, thus each has its independent utility. See MPEP § 806.05(d).

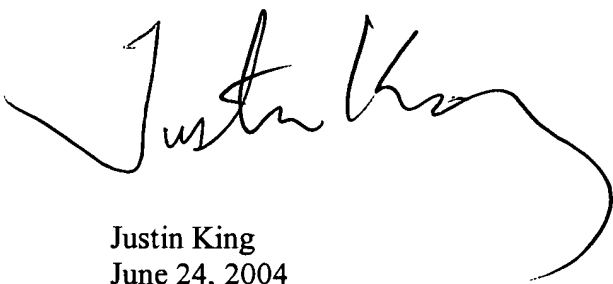
8. Because these inventions are distinct for the reasons given above and the search required for each of first, second, third, and forth inventions is different; and because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin I. King whose telephone number is 703-305-4571. The examiner can normally be reached on Monday through Friday, 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on 703-308-3110. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Justin King  
June 24, 2004



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